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WELSH & KATZ, LTD
120 S RIVERSIDE PLAZA
22ND FLOOR
CHICAGO IL 60606

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OFFICE OF PETITIONS

In re Application of :
James, et al. : DECISION
Application No. 09/675,597 :
Filing Date: 29 September, 2000 :
Attorney Docket No.: 99EC036/77527 :
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This is a revised decision on the petition filed on 14 April, 2006, alleging unavoidable delay under 37 C.F.R. §1.137(a).

NOTE: **In matters such as this in which Petitioner observes that the Office has not responded to Petitioner's filing(s), Petitioner may find it of particular value and import (to demonstrate or otherwise evidence at a later date Petitioner's diligence in attention to such matters) to calendar a Status Inquiry at four-(4-) month intervals.**

For the reasons set forth below, the petition as considered under 37 C.F.R. §1.137(a) is **GRANTED**.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to a final Office action mailed on 16 September, 2003, with reply due absent extension of time on or before 16 December, 2003;
- the application went abandoned after midnight 16 December, 2003;
- it appears that the Office, for reasons not indicated, mailed the Office action in question to an address other than that of record and did not acknowledge or follow-up on the letter so indicating that fact filed of record on 2 October, 2003;
- Petitioner, apparently unaware of the Office action in question, filed an IDS in the record on 13 February, 2004, but there was no activity of record thereafter until the filing of the instant petition;
- it does not appear that the Office mailed a Notice of Abandonment before the instant petition was filed;
- on 14 April, 2006, Petitioner filed the instant petition under 37 C.F.R. §1.137(a), a reply in the form of an amendment, and made a showing of unavoidable delay;
- Petitioner's further showing in this matter approximates the requirements outlined at MPEP §711.03(c).

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).¹

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for

¹ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

the reply now to be accepted on petition.²

Delays in responding properly raise the question whether delays are unavoidable.³ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁴ And the Petitioner must be diligent in attending to the matter.⁵ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁶)

As to Allegations of Unavoidable Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(a) are the petition and fee, a showing of unavoidable delay, a proper reply, and—where appropriate—a terminal disclaimer and fee.

Petitioner appears to have satisfied the regulatory requirements.

CONCLUSION

The petition under 37 C.F.R. §1.137(a) is granted.

The instant application is forwarded to Technology Center 2600 for further processing in due course.

² Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

³ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁴ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁵ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

⁶ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.
Senior Attorney
Office of Petitions